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Paper No. 11

In re Application of
Mark S. Crowder *et al*
Application No. 09/975,642
Filed: October 10, 2001
Attorney Docket No. 3123-380

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: DECISION ON PETITION
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This is a decision on the petition filed on October 17, 2003 by which petitioner requests review of and withdrawal of the examiner's restriction requirements, of which there have been two to date. The petition is considered pursuant to 37 CFR 1.144 and 1.181, and no fee is required.

The petition is granted.

Prosecution History To Date

A review of the record shows that this application was originally assigned to Technology Center 2600. The first action on this application, paper No. 5 dated May 13, 2003, was a requirement by the examiner in Technology Center 2600 to restrict the claims in this application to one of two allegedly distinct inventions. These inventions were described as being:

Group I, claims 1-31 and 43-50 drawn to a method for reducing corrosion of a head element during rework operations and methods for shipping and storing; and

Group II, claims 32-42 and 51-63, drawn to an improvement and a subcombination.

The record shows that on March 19, 2003, an examiner in Technology Center 3700 indicated approval of the claims in Group I for examination in Technology Center 3700 by initialing those claims as being acceptable for Class 29, subclass 603.03.

On June 12, 2003, petitioners elected the invention of Group I for prosecution in this application. The election was with traverse. Petitioners argued that the basis for the restriction between the claims of Group I and the claims of Group II was erroneous, inasmuch as the apparatus (*sic*, claims 32-42 and 51-63 are drawn to a product resulting from the Group I process) claimed in the Group II claims could not in fact be made by a process differing from the process as recited in the Group I claims because the broad Group I claims did not recite a testing step. It was the presence of this testing step in the Group I claims that was relied upon by the Technology Center 2600 examiner as distinguishing between the disk drive and head element recited in the Group II claims. Petitioners also pointed out that as all claims except four dependent process claims did not recite a "testing" step, and as the process claims and apparatus claims relied on the same limitations found, there was no serious burden on the examiner necessitating restriction. Coupled with the elections, the claims were amended concurrently with the election in a way that is immaterial to the issues at hand

As a result of the election of the Group I invention, the application was transferred to Technology Center 3700. On June 26, 2003, the examiner in Technology Center 3700 promulgated paper No. 7, which is a second restriction requirement. The examiner adhered to the restriction requirement as originally promulgated. The examiner opined that "even though there is no testing process in the claimed invention, the product as claimed can be made by another and materially different process." That process was described as "applying a protecting coating to the head element prior to remove (*sic*, removal of) the head element from the housing of the disk drive. The significance of these statements will be discussed, *infra*.

In addition to adhering to the original restriction requirement for somewhat different reasons than advanced by the Technology Center 2600 examiner, and making that restriction requirement final (37

CFR 1.143; MPEP § 821.01), the Technology Center 3700 examiner additionally required restriction between the inventions defined by claims 1-31, drawn to a method for reducing corrosion of a head element during rework operations and claims 43-50, drawn to a method of shipping a head element removed from a disk drive. The examiner based this additional restriction on the practice set forth at MPEP § 806.06(c) which governs restrictions between claims directed to a combination and claims directed to a subcombination of that combination. The examiner opined that claims 1-31 defined a combination, while claims 43-50 defined a subcombination of that combination. Claims 43-50 were indicated by an examiner in Class 53 as being proper in Class 53, and not Class 29. The examiner also then required an election of species in the event that "subcombination" claims 1-31 were elected, holding that this group of claims contained claims that were directed to seven distinct species. The examiner identified these species by listing the claims that the examiner felt defined the species.

Petitioners filed a reply to the second restriction requirement in paper No. 8, filed July 28, 2003. In the reply, petitioner traversed the newly reworked restriction requirement and of the requirement to elect species. The reply also included an election of certain claims, but the election was clearly not consonant with the requirement to restrict. Further, petitioners did not elect a species, notwithstanding that their election encompassed claims subject to the further requirement to elect species, because petitioners claimed that they could make no such election.

The examiner responded to paper No. 9, dated September 17, 2003, by holding that the reply in paper No. 8 was not fully responsive. The examiner held the reply to be a *bona fide* attempt to respond, and set a new shortened statutory period of one month or thirty days, subject to extensions of time under 37 CFR 1.136(a), in which to reply. See paper No. 10.

Petitioners reply to paper No. 10 has not yet been filed. Instead, petitioners filed the instant petition. Given the circumstances of the prosecution to date, in particular for reasons to be discussed *infra*, the reply embodied in paper No. 8 is deemed to be as complete as could have been filed.

The Disclosed Inventions

A review of the Summary of the Invention portion of the specification, at pages 3-7, shows that the instant invention i, in one aspect, directed to the situation in which a hard disk drive that was assembled needs to be serviced, that is reworked. In order to service or rework the drive, the drive's case must be opened. When the case is opened, the head element is exposed to the atmosphere and associated corrosives. The invention involves the recognition of this fact and the concept that a protective coating can be applied to the removed head element after the disk drive has been disassembled. The same concept, applying a protective coating, is disclosed to be applicable to head stack assemblies that need reworking either before installation or after removal from a previous installation. The disclosure further contemplates a preferred coating material, and a preferred manner of applying the coating by using one of several different film deposition processes, but other processes of applying the coating such as a vapor-mediated process. Cleaning of the component may optionally be performed prior to the coating, the coating may be post processed as by application of infrared or other engeries, and the coating could be applied in various thicknesses. A reassembled device may be tested. The above process is also disclosed as being useable when the drive or HSA is being shipped, or stored, rather than being replaced reassembled in the case of a component that was removed for reworking, or assembled in the case of a component that was not previously installed.

Various specific details of the invention can be gleaned from a reading of the Detailed Description at pages 8-13 in conjunction with the Brief Descriptio of the Drawings which can be found at pages 7 and 8.

The Claimed Invention

Claims 1-31 recite a method of reducing corrosion in a head element during a rework operation, wherein the head element had been initially contained with the housing of an assembled disk drive. The sole independent claim is claim 1, which reads:

1. A method for reducing corrosion of a head element during rework operations, said head element being initially contained within the housing of an assembled disk drive, said method comprising the steps of:

opening said housing of said disk drive;
removing said head element from said housing of said disk drive; and
applying a protective coating to said head element.

Claims 2-31 recite various details in accordance with the disclosure of the various options as discussed, *infra*, and as specifically described in the complete specification.

Claims 32-42 recite a disk drive that has been opened for reworking after it was once assembled, from which the head element was removed, with the head element having a coating that was applied to the head element after the head element was removed, which coating protects against corrosive effects of the atmosphere. The sole independent claim in this group of claims reads:

32. In a disk drive having at least one head element, said disk drive having been opened after assembly for purpose of reworking, and the head element having been removed, the improvement comprising:

a protective coating applied to said head element after removal of the head element to reduce corrosive effects from the surrounding atmosphere.

Claims 43-46 recited a method of shipping a head element that has been removed from a disk drive. The sole independent claim reads:

43. A method for shipping a head element removed from a disk drive, said method comprising the steps of:

removing said element from said disk drive;
applying a protective coating to said head element;
placing said head element into a container; and,
transporting said container.

Claims 47-50 recited a method of storing a head element that was removed from a disk drive. The sole independent claim reads:

47. A method for storing a head element removed from a disk drive, said method comprising the steps of:

removing said element from said disk drive;
applying a protective coating to said head element; and
placing said head element into a storage container.

Claims 51-63 are directed to the head element *per se*, as after the head element was has been removed from a disassembled and partially reworked disk drive. The sole independent claim reads:

51. In subcombination, from a disk drive that is disassembled and at least partially reworked, the subcombination comprising:

a head element for transferring data to and from said disk;
a protective coating on said head element applied after disassembly wherein disassembly includes removal of the head element from the disk drive.

Restriction practice is discussed in Chapter 800 of the Manual of Patent Examining Procedure. It is impossible in this decision to describe all of the nuances associated with this practice. Suffice it to say, however, that there are certain cardinal principles that govern the practice, and certain specific tests that must be satisfied when restriction between distinct inventions, or when an election between species, is properly promulgated. It is worth discussing some of the relevant principles and specific tests discussed in Chapter 800.

The authority to require restriction is conferred by 35 USC § 121. This section of the law reads, in pertinent part:

35 U.S.C. 121, Divisional applications.

"If two or more independent and distinct inventions are claimed in one application the Director may require the application to be restricted to one of the inventions." (Emphasis added.)

As discussed in MPEP § 802.01 the term "independent inventions" means that there is no disclosed relationship between the two or more subjects disclosed. An example is species under a genus which species are not usable together as disclosed. The term "distinct inventions" means "that two or more subjects are related, as for example, combination and part (subcombination) thereof, ... process and product made, etc., but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). (Emphasis in the original.)

With respect to species, MPEP § 801.01(a) states that when requiring an election of species, "[T]here must be a patentable difference between the species as claimed." See also MPEP § 806.04(h), which is **entitled** "Species Must Be Patentably Distinct From Each Other." In addition, MPEP § 806.04(e) states that "Claims are definitions of inventions. *Claims are never species.* Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (an thus be designated a *generic or species claim*). *Species are always the specifically different embodiments.*" (Emphasis in the original.)

Analysis of the Record in This Application

Applying the principles that govern restriction between distinct inventions and between independent inventions (species) to the specifically disclosed inventions and the claims directed thereto in this application, it is clear that the restriction and election requirements set for in paper No. 7 cannot be sustained. The reasons for this are:

1. As set forth, the requirement to restrict between claims 1-31 directed to a method of reducing corrosion in a head element during a rework operation, claims 43-46 directed a method of shipping a head element that has been removed from a disk drive and 47-50 directed to a method of shipping a head element that has been removed from a disk drive is predicated on combination, subcombination practice.
2. In making the combination, subcombination restriction, the examiner held that claims 43-50 were subcombination claims and claims 1-31 were combination claims. This is clearly erroneous since claims 1-31 are, as claimed, directed to an invention which is a subcombination of (that is, a part of) the combination invention to which claims 43-50 are directed. Claims 43-50 require the steps of removing an element from a disk drive, coating the element, and then placing the coated element in a container (and shipping the contained element or (inferentially) storing the contained element. Claims 1-31 are directed to opening a disk drive, removing the element and coating the element. It is also noted that claims 43-50 require that the step of opening the disk drive has taken place. Clearly, the invention to which claims 43-50 are directed include the invention to which claims 1-31 are directed, and therefore, claims 1-31 and the invention to which they are directed are a part of (that is, a subcombination of), the invention to which claims 43-50 are directed.

3. The election of species is clearly erroneous as set forth since it identifies species as being claims. The proper way to identify a species to which one or claims are directed (that is, one only offers a choice of a electing a species when there are one or more claims that are limited only to that species, MPEP § 806.04(f), is to identify the species with words, or by drawing figures if applicable. Here, for example, the species to which claim 3 is apparently directed should have been identified as "a method for reducing corrosion in which a protective coating is applied in a vacuum chamber." Note also that so-called species F is not really a separate species as disclosed, since the post-processing step is disclosed as being applicable to any of the disclosed ways of applying the coating.

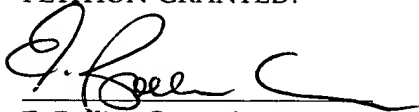
4. It is also noted that the making of the restriction requirement final in paper No. 7 was in fact improper because the examiner used a totally different rationale in paper No. 7 than was employed in paper No.

5. Apparently recognizing that the broad claims directed to the method of claims 1-31 were not restrictable from the broad claims directed to the disk drive of claims 32-42 and 51-63 because no testing step was required by the broad claims, the examiner switched rationales and held that the protective coating could be applied to the head element prior to removal of the head element from the housing of the disk drive. Given that claim 32 requires that the head element had been removed from the disk drive to be reworked and the applied coating was for the purpose of protecting the element from the corrosive effects of the atmosphere, it would appear that this new rationale is questionable at best. However, as it is certainly a new rationale, paper No. 7 should not have made the restriction requirement final.

Decision

For the foregoing reasons, the relief requested by petitioner will be granted. Specifically the restriction requirement and the election of species requirement are both reversed for reasons 1-3 set forth in the paragraph above, as well as for the reason that the requirement in paper No. 7 should not have been made final. The application is being forwarded to the Supervisory Patent Examiner (SPE) in Art Unit 3729. The SPE should review this application together with the examiner. If a decision is reached that a restriction requirement is proper, a new restriction requirement in strict compliance with the guidance in Chapter 800 of the Manual of Patent Examining Procedure, as discussed above and as it otherwise appears, should be promulgated. That requirement must reflect careful consideration of whether the inventions found to be distinct are in fact, *prima facie*, patentably distinct one from the other.

PETITION GRANTED.



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